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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,381	09/27/1999	PRASAD Y. CHEBROLU	062891.0299	1545

7590 01/19/2006
BAKER & BOTTS LLP
2001 ROSS AVENUE
DALLAS, TX 752012980

EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/406,381	CHEBROLU, PRASAD Y.	
	Examiner	Art Unit	
	DAVID Y. ENG	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The active claims remain 1-36.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaweethai (USP 5,546,379).

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

With respect to Applicants' remarks in the communication filed on November 11 2005, it is not seen how the amendment to insert "wherein for each of the modems, the performance attribute indicates operating performance of the modem as monitored over a period of operation of the modem" in independent claims 1, 10, 19 and 29 would address the Board's concern regarding the nature of the disclosed performance attributes. There is nowhere indicated by the Board in the opinion that the rejection of the claims based on Thawethai would be overcome if performance attribute is amended to indicate operating performance of the modem as monitored over a period of operation of the modem. In the Board's decision on April 28 2005, the Board affirms the 103 Rejection of claims 2, 11, 20 and 29 based on Thaweethai. The amended claim 1 is broader than the affirmed claim 2 in that the wherein clause is nothing but a desired functional statement. It does not include the apparatus, namely the monitoring and modifying module, for performing the desired function. Although it is noted that the wherein clause includes a limitation "—monitored over a period of operation of the modem" , that limitation "over a period of operation" is inherent in the act of monitoring.

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All monitoring requires a period of time, namely start and end of monitoring. There is no argument presented by Applicants as to why the wherein clause or "monitored over a period of operation" is patentable. Dynamic monitoring and updating have already been addressed by the Board. See line 3 of page 10 of the decision.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

A handwritten signature in black ink, appearing to read 'David Y. Eng', with a stylized, wavy line extending from the end.

DAVID Y. ENG
PRIMARY EXAMINER